

Global Tobacco Manufacturers (International) Sdn Bhd v Jamal Abdunaser Mahmoud Al
Mahamid
[2015] SGCA 51

Case Number : Civil Appeal No 51 of 2015
Decision Date : 29 September 2015
Tribunal/Court : Court of Appeal
Coram : Sundaresh Menon CJ; Chao Hick Tin JA; Tay Yong Kwang J
Counsel Name(s) : Lai Tze Chang Stanley SC, Goh En-ci Gloria and Clara Tung Yi Lin (Allen & Gledhill LLP) for the appellant; Yew Woon Chooi, Foo Maw Jiun and Quek Jie Ying (Rodyk & Davidson LLP) for the respondent.
Parties : Global Tobacco Manufacturers (International) Sdn Bhd — Jamal Abdunaser Mahmoud Al Mahamid

Trade Marks and Trade Names – Invalidation

[LawNet Editorial Note: This was an appeal from the decision of the High Court in [\[2015\] SGHC 42.](#)]

29 September 2015

Sundaresh Menon CJ (delivering the judgment of the court *ex tempore*):

1 This is an appeal against the order of the Judicial Commissioner (“the Judge”) invalidating the following mark of which the Appellant was the registered proprietor (“the Appellant’s Mark”):



2 The Respondent is the registered proprietor of the following mark (“the Respondent’s Mark”):



3 The contesting marks were both registered in respect of Class 34 goods and services which comprises cigarette and related products. The Respondent’s Mark was the first to be registered in Singapore, the date of registration being 7 June 2005. The application for registration of the Appellant’s Mark was filed on 8 June 2012, and it was successfully registered on 29 November 2012 without any opposition despite the Appellant having advertised its application for registration on 14 September 2012.

4 Cigarettes bearing the Respondent’s Mark were sold in Singapore through duty-free channels,

primarily to ship chandlers (*ie*, retail dealers specialising in providing supplies to ships) who would then resell the same to personnel on ships arriving at Singapore ports.

5 The Respondent brought the action to invalidate the registration of the Appellant's Mark. After a trial, the Judge found that the Appellant's Mark was in breach of s 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act") and ordered it to be invalidated under s 23(3)(a)(i) of the Act. The Appellant brings the present appeal against the Judge's decision.

6 We begin with some preliminary observations which we conveyed to counsel for the Appellant, Dr Stanley Lai SC ("Dr Lai") at the outset of his submissions. We consider in this case that:

- (a) the dominant element of both the composite marks is the textual component, "Manchester";
- (b) the non-textual component has limited impact in differentiating the marks;
- (c) the textual component is inherently distinctive in relation to the goods in question, namely, cigarettes;
- (d) the textual component of both marks is identical; and
- (e) the marks are identical aurally and substantially similar visually and conceptually.

7 In these circumstances, we consider that there is a high degree of similarity between the marks.

8 The question then turns on the likelihood of confusion. The case law is clear that the likelihood of confusion may be proved as a matter of inference and that one undertakes an objective inquiry into this. In our judgment, two points flow from this:

- (a) First, the greater the degree of similarity between the goods and the marks, the more readily will the likelihood of confusion be found; and
- (b) Second, evidence of actual confusion, although helpful, is not a necessary element of the cause of action.

9 In the course of his arguments, Dr Lai framed his argument by reference to the fact that the Respondent is seeking to *invalidate* the Appellant's mark and hence to displace rights that had been duly conferred pursuant to registration effected in accordance with the appropriate procedures and which had hitherto been lawfully exercised and indeed may continue to be exercised until the registered mark has been invalidated. Dr Lai accepted that on the plain meaning of the relevant statutory provisions, the fact that the process for registration had been complied with did not foreclose a subsequent application being brought to invalidate the mark. However, he argued that the fact that the mark had been duly registered meant that the respondent had the burden of showing to a *convincing* degree the likelihood of confusion. Although he did not quite frame it in this way, it seemed to us that he was suggesting that more evidence would be required to discharge the burden of proving the likelihood of confusion. Against the background of this submission, he placed reliance on the fact that there had been no evidence of actual confusion led by the respondent in the proceedings below. Nor was there evidence of how particular segments of the likely consumer base might perceive the respective trademarks or of how consumers may (or may not) be confused. Counsel for the Respondent, Ms Yew Woon Chooi ("Ms Yew") challenged these contentions.

10 We first reiterate that evidence of actual confusion is not a necessary element of the cause of action. In *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd and another* [2013] 2 SLR 941 at [100], we explained some of the reasons why this should not be given undue weight. Ms Yew also pointed to the relatively low level of sales of the Appellant's products over the course of the last few years since the registration of its mark as one of the factors that militate against placing much weight on the absence of evidence of actual confusion in the present case. Ms Yew further noted that an application may be brought to invalidate a registered mark that had not yet been used at all and in such cases there could be no evidence of actual confusion. She submitted that it would be unsatisfactory to have different tests that varied with the factual circumstances of each case.

11 Although Dr Lai may be correct that the issue of the precise approach to be taken in respect of the burden of proof in such cases where an application is made to invalidate a duly registered trademark, has not been the subject of a reported decision, we are satisfied that it is not necessary for us to reach a conclusive view on this point in this case. This is because, given: (a) our finding that there exists a high degree of similarity between the marks; and (b) the fact that the goods are identical, we are satisfied that there was (and is) sufficient material on which the Judge could fairly infer the existence of a sufficient likelihood of confusion, and therefore to reach the view that he did reach, namely that the registration was in breach of s 8(2)(b) of the Act and hence to be invalidated under s 23(3)(a)(i) of that Act.

12 For these reasons, we dismiss the appeal. We order that that the costs of this appeal and of the proceedings below are to be taxed if not agreed. There will be the usual order for the payment out of the security.